

**RECEIVED
CENTRAL FAX CENTER****MAY 07 2009****PATENT
Docket No. 58359US003****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant(s):	BURGIO et al.)	Group Art Unit:	1612
)		
Serial No.:	10/626,142)	Examiner:	Darryl C. Sutton
Confirmation No.:	9324)		
)		
Filed:	July 24, 2003)		
)		
For:	<u>DENTAL WHITENING COMPOSITIONS AND METHODS</u>			

PETITION UNDER 37 C.F.R. §1.181(a)

Commissioner for Patents
Mail Stop Petition
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This petition is being submitted under 37 C.F.R. §1.181(a) to request designation of New Grounds of Rejection in the Examiner's Answer mailed March 9, 2009, pursuant to M.P.E.P. §1207.03(IV). It is believed that no fee is required for this petition. However, in the event that a fee is required, please charge the fee to Deposit Account No. 13-4895.

Remarks begin on the page entitled "Remarks."

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Confirmation No.: 9324

Filed: July 24, 2003

For: DENTAL WHITENING COMPOSITIONS AND METHODS**Remarks**

Appellants respectfully submit that the Examiner's Answer mailed March 9, 2009 includes New Grounds of Rejection.

First, the Examiner added a heretofore uncited document in Section (8), Evidence Relied Upon (page 4 of the Examiner's Answer mailed March 9, 2009). The Examiner listed the "Carbonyl Compounds" document on a PTO-892 form attached to the Examiner's Answer mailed March 9, 2009, thus confirming that the document was newly cited. Appellants further note that the document was used to support the Examiner's arguments on page 9, lines 5-7 of the Examiner's Answer mailed March 9, 2009.

It is Appellants position, in view of the newly cited art relied upon by the Examiner, that each of the present rejections constitutes a New Ground of Rejection pursuant to M.P.E.P. §1207.03(III):

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). **>Where< a newly cited reference is added merely as evidence of the prior ** statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)<.

Appellants respectfully submit that what was "well-known" in the art was not challenged for the first time in the Appeal Brief submitted November 7, 2008.

However, Appellants note that the Examiner did not include the cited document in the statement of the rejection as would be required by M.P.E.P. §1207.03(III) for a New Ground of

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Rejection. Moreover, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

Appropriate correction is respectfully requested.

Second, in the Final Office Action mailed June 6, 2008, the Examiner listed claims 6-7, 12-13, 20-21, 23-25, 27-29, and 65-68 as rejected under 35 U.S.C. §103(a) as unpatentable over Mitra et al. (U.S. Patent No. 5,888,491) in view of Majeti et al. (U.S. Patent No. 7,025,950), the combination being taken in further view of Aasen et al. (U.S. Patent No. 4,871,786).

The Examiner's Answer included claim 49 in this rejection. As such, Appellants are interpreting the inclusion of claim 49 as a New Ground of Rejection.

However, as noted above, there was no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

Appropriate correction is respectfully requested.

Third, in the Final Office Action mailed June 6, 2008, the Examiner listed claims 30-32, 34-35, 37-43, 45, 50-52, and 60-68 as rejected under 35 U.S.C. §103(a) as unpatentable over Rozzi et al. (U.S. Patent No. 5,607,663) in view of Majeti et al. (U.S. Patent No. 7,025,950).

The Examiner's Answer included claims 69-80 in this rejection. As such, Appellants are interpreting the inclusion of each of claims 69-80 as a New Ground of Rejection.

However, as noted above, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

Appropriate correction is respectfully requested.

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Summary

For the foregoing reasons, Appellants respectfully request that if the Director decides that the rejections in the Examiner's Answer mailed March 9, 2009 are considered New Grounds of Rejection and approves the New Grounds of Rejection, then the Director is respectfully requested to require the Examiner to send a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee, pursuant to M.P.E.P. §1207.03(IV).

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7th day of May, 2009, at 1:05 pm (Central Time).

By: Name: Dani Moroz

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REPLY BRIEF

Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is presented in response to the Examiner's Answer mailed March 9, 2009, received in response to Appellant's Appeal Brief submitted November 7, 2008. Appellants maintain the request that the Board reverse all of the final rejections of the pending claims as discussed in the Appellant's Appeal Brief submitted November 7, 2008.

Remarks begin on the page entitled "Remarks."

Reply Brief

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Remarks

Appellants respectfully submit that the Examiner's Answer mailed March 9, 2009 is unclear. For example, the Examiner's Answer appears to have been prepared using a "track changes" mode, and the changes were apparently neither accepted nor rejected. As a result, the Examiner's Answer contains information that is underlined and information in balloons in the right margin. It is not clear to Appellants' Representatives whether the Examiner's Answer was intended to *include* or *exclude* information that is underlined and information in balloons in the right margin. However, in an effort to fully and properly respond to the Examiner's Answer, wherever appropriate Appellants are indicating herein, whether the specific information that is underlined or in balloons in the right margin is being interpreted as included in or excluded from the Examiner's Answer mailed March 9, 2009.

Section 8: Evidence Relied Upon

Appellants note that the Examiner added a heretofore uncited document as *underlined information* in Section (8), Evidence Relied Upon (page 4 of the Examiner's Answer mailed March 9, 2009). The Examiner listed the "Carbonyl Compounds" document on a PTO-892 form attached to the Examiner's Answer mailed March 9, 2009, thus confirming that the document was newly cited. Appellants further note that the document was used to support the Examiner's arguments on page 9, lines 5-7 of the Examiner's Answer mailed March 9, 2009.

It is Appellants position that if the newly cited document was intended to be *included* in the Appeal Brief to support the rejections, then each of the present rejections would constitute a New Ground of Rejection pursuant to M.P.E.P. §1207.03(III):

A new prior art reference >applied or< cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the

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statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). ****>Where<** a newly cited reference is added merely as evidence of the prior **** statement** made by the examiner **>as to what is "well-known" in the art which** was challenged for the first time in the appeal brief<, the citation of the reference in the examiner's answer would not **>ordinarily<** constitute a new ground of rejection within the meaning of 37 CFR ***> 41.39(a)(2)<**.

Appellants respectfully submit that what was "well-known" in the art was not challenged for the first time in the Appeal Brief submitted November 7, 2008. Further, Appellants note that the Examiner did not include the cited document in the statement of the rejection as would be required by M.P.E.P. §1207.03(III) for a New Ground of Rejection. Moreover, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

For at least these reasons, Appellants are interpreting the underlined "Carbonyl Compounds" document as intended by the Examiner to be *excluded* from the Examiner's Answer mailed March 9, 2009.

*Section 9: Grounds of Rejection**Grounds of Rejection (I)*

In the Final Office Action mailed June 6, 2008, the Examiner listed claims 1-3, 5, 8-11, 14-17, 19, 22, 30-32, 34, 36-43, 45-64, and 69-80 as rejected under 35 U.S.C. §103(a) as unpatentable over Mitra et al. (U.S. Patent No. 5,888,491) in view of Majeti et al. (U.S. Patent No. 7,025,950).

The Examiner's Answer did not include claim 49 in this rejection. As such, Appellants are interpreting the omission of claim 49 as acknowledgement that claim 49 is patentable over Mitra et al. in view of Majeti et al.

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Grounds of Rejection(2)

In the Final Office Action mailed June 6, 2008, the Examiner listed claims 6-7, 12-13, 20-21, 23-25, 27-29, and 65-68 as rejected under 35 U.S.C. §103(a) as unpatentable over Mitra et al. (U.S. Patent No. 5,888,491) in view of Majeti et al. (U.S. Patent No. 7,025,950), the combination being taken in further view of Aasen et al. (U.S. Patent No. 4,871,786).

The Examiner's Answer included claim 49 in this rejection. As such, Appellants are interpreting the inclusion of claim 49 as a New Ground of Rejection.

However, as noted above, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

As such, Appellants are interpreting the Examiner's Answer mailed March 9, 2009 to be an indication that claim 49 has been allowed.

Grounds of Rejection(3)

In the Final Office Action mailed June 6, 2008, the Examiner listed claims 30-32, 34-35, 37-43, 45, 50-52, and 60-68 as rejected under 35 U.S.C. §103(a) as unpatentable over Rozzi et al. (U.S. Patent No. 5,607,663) in view of Majeti et al. (U.S. Patent No. 7,025,950).

The Examiner's Answer included claims 69-80 in this rejection. As such, Appellants are interpreting the inclusion of each of claims 69-80 as a New Ground of Rejection.

However, as noted above, there is no indication in the Examiner's Answer that a New Ground of Rejection was (A) approved by a Technology Center (TC) Director or designee; and (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer, as required under M.P.E.P. §1207.03(I).

As such, Appellants are interpreting the Examiner's Answer mailed March 9, 2009 to be an indication that claim 69-80 are patentable over Rozzi et al. in view of Majeti et al.

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Section 10: Response to Argument

Appellants respectfully reiterate that the Examiner has improperly relied on Mitra et al. and/or Rozzi et al. for disclosing a polymer that includes, among other things, a repeating unit including a polar or polarizable group and a repeating unit including a fluoride releasing group, *wherein the repeating unit including the polar or polarizable group is different than the repeating unit including the fluoride releasing group.*

Further, Appellants respectfully submit that the Examiner's position that the ester group in a poly(alkylmethacrylate) is a polar group is simply not consistent with the present specification, Mitra et al., and/or Rozzi et al., as further discussed herein below.

The present specification describes polar or polarizable groups:

Repeating units including a polar or polarizable group are derived from vinylic monomers such as acrylates, methacrylates, crotonates, itaconates, and the like. The polar groups can be acidic, basic or salt. These groups can also be ionic or neutral.

Examples of polar or polarizable groups include neutral groups such as hydroxy, thio, substituted and unsubstituted amido, cyclic ethers (such as oxanes, oxetanes, furans and pyrans), basic groups (such as phosphines and amines, including primary, secondary, tertiary amines), acidic groups (such as oxy acids, and thiooxyacids of C, S, P, B), ionic groups (such as quarternary ammonium, carboxylate salt, sulfonic acid salt and the like), and the precursors and protected forms of these groups. Additionally, a polar or polarizable group could be a macromonomer. More specific examples of such groups follow.

(Page 8, line 29 to page 9, line 8 of the present specification). The present specification describes further examples of polar or polarizable groups as including carboxyl groups, hydroxyl groups, amino groups, alkoxyalkyl groups, ammonium groups, and sulfonic acid groups (e.g. page 9, line 9 to page 11, line 12 of the present specification).

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The specifications of Mitra et al. and Rozzi et al. each similarly describe polar or polarizable groups:

More specifically, the unit A is derived from vinylic monomers such as acrylates, methacrylates, crotonates, itaconates and the like. The polar groups can be acidic, basic or salt. These groups can also be ionic or neutral.

Examples of polar or polarizable groups include neutral groups such as hydroxy, thio, substituted and unsubstituted amido, cyclic ethers (such as oxanes, oxetanes, furans and pyrans), basic groups (such as phosphines and amines, including primary, secondary, tertiary amines), acidic groups (such as oxy acids, and thiooxyacids of C, S, P, B) and ionic groups (such as quarternary ammonium, carboxylate salt, sulfonic acid salt and the like) and the precursors and protected forms of these groups. Additionally, A could be a macromonomer. More specific examples of such groups follow.

(Column 3, lines 44-58 of Mitra et al.; column 2, line 64 to column 3, line 11 of Rozzi et al.).

Mitra et al. and/or Rozzi et al. describe further examples of polar or polarizable groups as including carboxyl groups, hydroxyl groups, amino groups, alkoxyalkyl groups, ammonium groups, and sulfonic acid groups (e.g. column 3, line 59 to column 5, line 10 of Mitra et al; column 3, line 12 to column 4, line 29 of Rozzi et al.).

Appellants respectfully submit that it would be abundantly clear to one of skill in the art, in view of the present specification and the specifications of Mitra et al. and/or Rozzi et al., that the ester group in a poly(alkylmethacrylate) is not a polar group as described in the present specification.

For at least this reason, Appellants respectfully submit that all the present claims are patentable over the cited art.

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Summary

For the foregoing reasons, in addition to the reasons recited in the Appeal Brief filed November 7, 2008, Appellants respectfully request that the Board review and reverse the rejections of all the pending claims as discussed herein, and that notification of the allowance of these claims be promptly issued.

Respectfully submitted

By

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Date

May 7, 2009By: 

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to **Mail Stop Appeal Brief - Patents**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7th day of May, 2009, at 1:05 pm (Central Time).

By: Name: Dani Moritz